

REMARKS

Claims 2-8 are pending in the application. In the Office action dated July 11, 2008, claims 2-8 were rejected. Applicant has amended claim 4. In view of the following remarks, Applicant respectfully requests that the amendment be entered, that the finality of the rejections be withdrawn, and that the rejected claims be reconsidered.

The Finality of the Rejection is Improper

The Examiner has applied newly cited prior art in formulating the present rejections. In making the action Final, the Examiner has asserted that the new grounds of rejection were necessitated by Applicant's amendment. Applicant respectfully disagrees, and suggests the Finality of the rejection is improper.

As clearly set out in Applicant's previous response, the amendments made to claim 4 were in response to the Examiner's objections to claims 2 and 4. The amendments were intended to provide antecedent basis for the claim element "the fold line", and to more clearly describe the vertex of the limb of the clip. Neither of these amendments addressed issues related to cited prior art.

The Examiner has failed to indicate precisely how Applicant's previous amendment "necessitated" the citing of new prior art, but referred to MPEP § 706.07(a) in doing so.

However, MPEP § 706.07(a) is clear in stating that a second or any subsequent action on the merits should not be made final if it includes a rejection on prior art not of record of any claim amended to include limitations which should reasonably have been expected to be claimed. In the present case, Applicant's amendments were not intended to further limit or modify the claimed subject matter, but rather to more clearly define the

claimed subject matter in response to objection by the Examiner. Applicant notes that MPEP § 706.07(a) provides, as an example of an improper final rejection, the case where an Applicant has amended a claim to overcome a rejection under 35 U.S.C. § 112, second paragraph.

For at least the reason that Applicant's previous amendment did not address rejections over prior art, but was solely directed at improving the clarity of the claims, Applicant respectfully suggests that the finality of the Office action dated July 11, 2008 is improper, and should be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 4-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shuey (U.S. Patent no. 1,148,934). Applicants respectfully disagree.

As recited in independent claims 4 and 8, the claimed clips include two limbs and a pre-tensioned back configured to apply a force to the limbs. The clip is configured to be U-shaped, with limbs parallel to each other in a relaxed state. Each limb of the clip includes a small inward fold of less than 90 degrees that defines a fold line, and the fold line is disposed at an acute angle with respect to the pre-tensioned back, or the fold is disposed at the region of each limb furthest from the back. The clip is configured so that it can clamp sheets of paper, plastic, metal etc., between the limbs by virtue of the force applied by the pre-tensioned back.

The Shuey clip is depicted in Figs. 1 and 2, reproduced below:

Fig. 1.

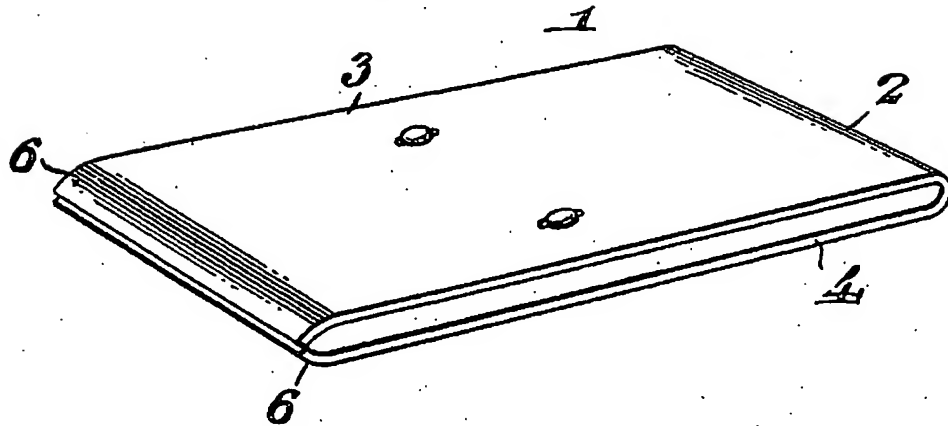
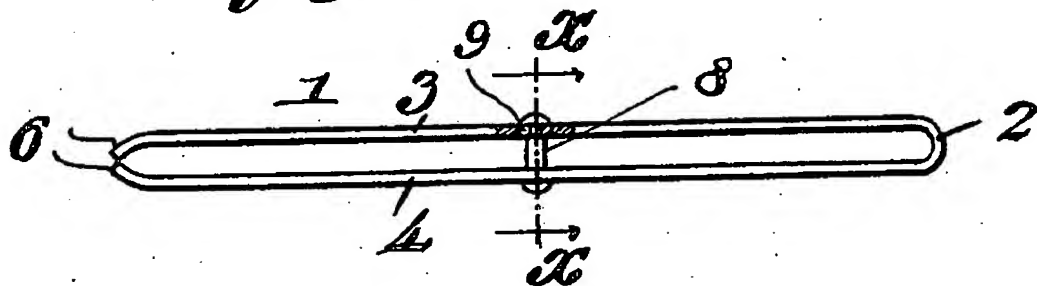


Fig. 2.



As set out at col. 1, lines 34-41 of Shuey:

My invention further consists in a clip constructed of a single piece of metal, bent upon itself at its medial portion to form a pair of normally closed gripping jaws, and the said jaws being provided at a point intermediate their ends with a fulcrum, so that pressure applied to the clip adjacent the bent end will cause the jaws to open.

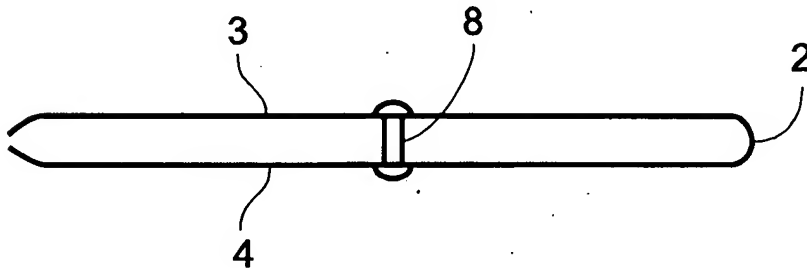
The Examiner asserts that the clip of Shuey is configured so that sheets are clamped between the limbs by virtue of the force applied by the pre-tensioned back. Applicants respectfully disagree. Although Shuey states that "the metal is so bent that

the portion 2 acts as a spring in normally forcing the leaf ends together", the incorporation of fulcrum points 8 in the clip forces the careful consideration of that description.

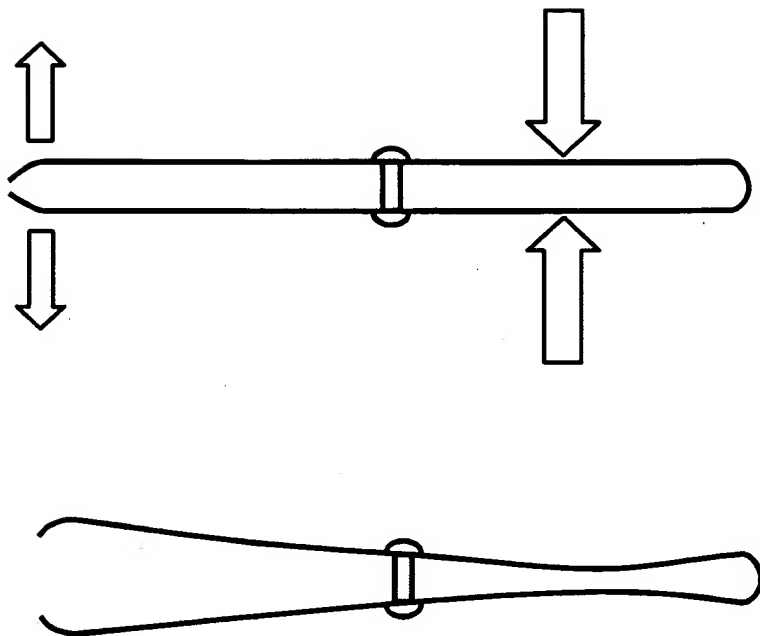
As stated at col. 2, lines 75-81,

...it is obvious that the clip may be easily operated, that is, the jaws may be readily opened by exerting pressure with the fingers upon the portions of the opposite leaves 3 and 4 in the rear of the fulcrum, or between the fulcrum and the spring 2.

The mechanical functioning of the Shuey clip is perhaps better shown through the following schematics. First a representation of the clip itself, as viewed from the side:



The studs 8 which act as a fulcrum point are clearly shown. Compression of the leaves 3 and 4 at a point between the fulcrum point and spring 2 serves to flex the leaf springs and open the clip:



Upon release, the construction of the clip ensures that the jaws will reclose: "When the clip has been engaged over the paper or fabric and released, the jaws, through the spring portion 2, will be forced together to firmly engage the material. col. 2, lines 81-85). Clearly, however, the jaws are not forced together by a compressive force applied by spring 2, because the construction of the clip ensures that any compression of the leaves between the fulcrum and spring 2 results in the jaws being opened.

Applicant suggests that the clip of Shuey operates in a manner that is precisely the opposite of the claimed clip, and that the Shuey reference fails to anticipate the pending claims. However, in order to even further distinguish the claimed clips from the clip of Shuey, Applicant has amended claim 4 to state that sheets may be clamped between the limbs by virtue of the compressive force applied by the pre-tensioned back.

As the spring of Shuey cannot clamp the jaws of the disclosed clip through application of a compressive force at the back, Applicant respectfully suggests that the

withdrawal of the rejection of claims 4-8 under 35 U.S.C. § 102.

Rejections under 35 U.S.C. § 103

Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shuey in view of Burleigh et al. (U.S. Patent no. 2,310,835). Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shuey.

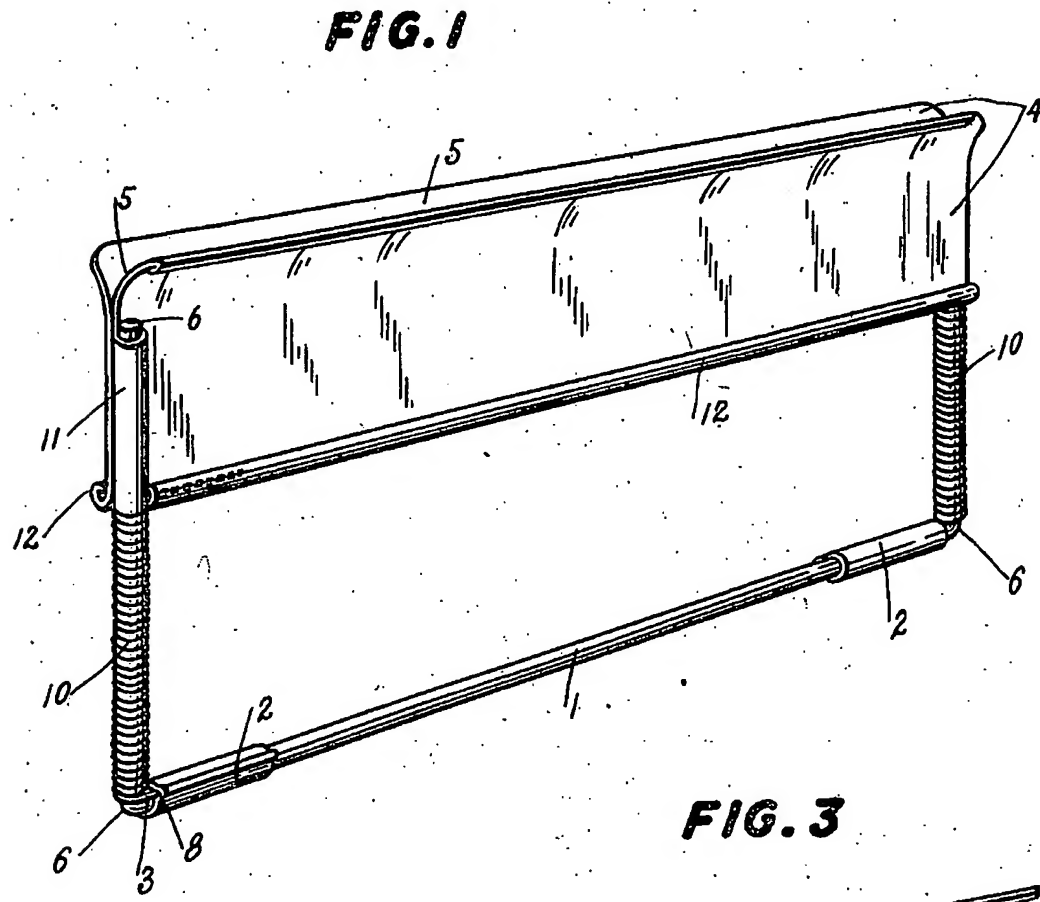
The Examiner asserts that Shuey discloses a clip having all the features of the clip of claim 4, and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange both limbs on top of each other and parallel to each other in a state with a clamped stack of sheets by means of a spring as taught by Burleigh in the clip disclosed by Shuey. Applicant respectfully disagrees.

The Examiner asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the clip being characterized by the fact that each limb is triangular, trapezoidal, semicircular, or semielliptical since a change in the shape of a prior art device is a design consideration within the skill of the art. Applicant respectfully disagrees.

As discussed above, the Shuey reference fails to disclose the clip of claim 4. Furthermore, one of ordinary skill would not be led to combine the clip of Shuey with the clip of Burleigh.

The clip of Burleigh is intended to gently hold letters or other stackable papers in a manner "permitting the withdrawal of one or more letters from the stack without disturbing the position of the remainder" (col. 1, lines 9-17). To facilitate this use, the Burleigh clip includes grippers having upper edge that are "flared outwardly to form, with the upper edge of the oppositely disposed gripper, open lips 5 between which letters,

billheads and the like may be inserted therebetween without the necessity of spreading apart the grippers themselves" (col. 2, lines 7-12). This configuration is best observed in Fig. 1 of Burleigh, show below:



The clip of Burleigh therefore operates contrary to the principles of operation of the Shuey clip in at least two respects: First, in having outwardly flared edges, rather than the inwardly directed jaws of Shuey, and second in utilizing a compressive force to urge the grippers together, rather than the use of a fulcrum and leaf spring to convert expansive resilience into a gripping force, as is the case for the clip of Shuey.

Where a proposed modification changes the principle of operation of a reference,

or renders the prior art unsatisfactory for its intended purposes, there can be no motivation to modify the reference as suggested by the Examiner (MPEP § 21043.01).

Furthermore, and with respect to the rejection of claim 6, Applicant strongly disagrees with the Examiner's statement that "the clip will perform equally as well regardless whether the shape of each limb is rectangular, triangular, trapezoidal, semicircular, or semielliptical" (page 5, para. 5 of the action). As discussed in the specification, the clips of the invention can clamp a stack of sheets securely, without damaging the sheets, by virtue of the combination of spring-loaded triangular or trapezoidal or semicircular or semielliptical limbs and inwardly bent folds. The clamping effect of such clips is almost comparable with that of a positive locking clip, and yet the clip may be readily removed, unlike a locking clip.

As Shuey and Burleigh, taken singly or in combination, fail to disclose each and every element of the rejected claims, and further as there can be no motivation to combine the disclosures of Shuey and Burleigh, Applicant respectfully suggests that the Examiner has failed to establish the prima facie obviousness of claims 2, 3, and 6. Applicant therefore respectfully requests the withdrawal of the rejection of claims 2, 3, and 6 under 35 U.S.C. § 103.

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, Applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims.

However, if the Examiner has any questions, or if a telephone communication could in any way advance prosecution of the application, the Examiner is urged to contact the undersigned agent of record.

CERTIFICATE OF MAILING

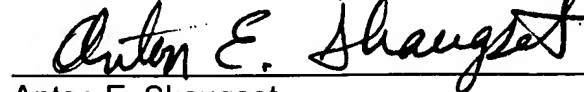
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